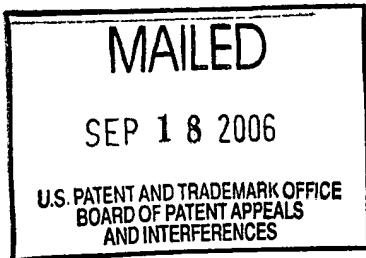


UNITED STATES PATENT AND TRADEMARK OFFICE



BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte H. WILLIAM BOSCH,
KEVIN D. OSTRANDER and EUGENE R. COOPER

Application 09/190,138

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was received electronically at the Board of Patent Appeals and Interferences on August 25, 2006. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being electronically returned to the examiner. The matters requiring attention prior to docketing are identified below:

An examination of the Image File Wrapper (IFW) reveals that an Appeal Brief was filed on March 17, 2006.

37 CFR § 41.37(c)(1)(v) (2005) reads as follows:

(c)(1) The brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(i) through (c)(1)(x) of this section, except that a brief filed by an appellant who is not represented by a registered practitioner need only substantially comply with paragraphs (c)(1)(i) through (c)(1)(iv) and (c)(1)(vii) through (c)(1)(x) of this section:

....

(v) *Summary of claimed subject matter.* A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

The “Summary of claimed subject matter” appearing on pages 3 and 4 of the Appeal Brief filed March 17, 2006 is deficient because it does not map the independent claims to the specification. Correction is required.

In addition, an Information Disclosure Statement (IDS) was filed on June 24, 2003. It is not apparent from the record whether the examiner considered the statement submitted or notified appellants regarding why their submission did not meet the criteria set forth in 37 CFR §§ 1.97 and

1.98. In addition, an IDS was filed on September 27, 1999 which was partially considered. It is not apparent from the record whether the examiner considered the Soviet Union Abstract No. 628930 located under “Other Documents.” A communication notifying appellants of the Primary Examiner’s decision is required.

Lastly, an Examiner’s Answer was mailed on May 26, 2006 which stated on page 2 that the status of claims contained in the brief¹ is correct.

However, the grounds of rejection are listed as follows:

(a) Claims 11-34, 40, 41, 44, 45, 47, 48, 51-62, 69-96, and 111-119 are rejected under 35 U.S.C. § 103(a) over Edwards et al. U.S. Patent No. 5,985,309 (“Edwards” or “’309”) [page 3];

(b) Claims 11-34, 40-45, 47, 48, 51-62, 69-96, and 97-119 are rejected under 35 U.S.C. § 103(a) over Edwards et al. U.S. Patent No. 5,985,309 in view of Liversidge U.S. Patent No. 5,145,684 (“Liversidge”) [page 4];

(c) Claims 35, 36, 49, 63, and 64 are rejected under 35 U.S.C. § 103(a) over Edwards et al. U.S. Patent No. 5,985,309 in view of Dalby et al. U.S. Patent No. 5,202,110 (“Dalby”) [page 5]; and

¹ Status of Claims [Appeal Brief, page 2]

Pending claims: 11-36, 40-45, 47-49, and 51-121.

Rejected claims: 11-36, 40-45, 47-49, and 51-121.

Appealed claims: 11-36, 40-45, 47-49, and 51-121.

(d) Claims 120 & 121 are rejected under 35 U.S.C. § 103(a) over Edwards et al. U.S. Patent No. 5,985,309 in view of Goodman & Gilman's, "The Pharmacological Basis of Therapeutics, Ninth edition, McGraw-Hill, 1996, page 666 ("Goodman") [page 5].

It should be noted that the Examiner's Answer fails to discuss the rejection of claims 65-68.² Correction is required.

Accordingly, it is

ORDERED that the application is returned to the Examiner:

- 1) for notification to appellant to submit a substitute Appeal Brief which corrects the "Summary of Claimed Subject Matter";
- 2) for consideration of the substitute Appeal Brief;
- 3) for consideration of the IDS filed June 24, 2003 and written notification to appellants regarding the Primary Examiner's decision;
- 4) for consideration of the Soviet Abstract No. 628930 appearing in the IDS filed September 27, 1999 and written notification to appellants regarding the Primary Examiner's decision;
- 5) for a determination regarding the status of claims 65-68; and

² The Final Rejection mailed January 14, 2004 includes claims 65-68 in rejection (b).

6) for such further action as may be appropriate.

BOARD OF PATENT APPEALS
AND INTERFERENCES

By: 

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